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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,090	06/30/2006	Nobuyuki Tonegawa	00862.119998.	6055
5514 7590 10/12/2010 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER				
FAN, HUA				
ART UNIT		PAPER NUMBER		
2456				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/585,090

**Applicant(s)**

TONEGAWA, NOBUYUKI

**Examiner**

HUA FAN

**Art Unit**

2456

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 6/25/2010

**DETAILED ACTION**

1. This office action is in response to amendment/reconsideration filed 8/20/2010, the amendment/reconsideration has been considered. Claims 18-21 are pending for examination, the rejection cited as stated below.

***Response to Arguments***

2. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 18-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 18 and 21 recites "describing the first character codes acquired by the first acquiring unit in a data area in a first part of the e-mail and the first classification information...". As recited in the earlier limitations, the first data were obtained by OCR'ing an image, and the second data were obtained by user input. Such a multi-part email with first data part obtained via OCR and the second data part obtained by user input, each having their character codes identified and classified, does not have sufficient support in the originally filed application. All new matters need to be cancelled.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 18 and 21 recites "...and a second classification information which indicates a type of the second character codes...". It is not clear how this classification information was obtained. As recited in earlier limitations, "a first classification information" that indicates a type of the first character codes was identified by "an identification unit". It is not clear whether the "second classification information" was identified using the same mechanism or another mechanism, and if the latter, which one.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 18-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hockey (US 2004/0064515), in view of Ayako ("Document Recognizer and language processor", submitted by IDS).

As to claim 18, Hockey discloses a communication apparatus which is connectable to a network and which is configured for generation of a multipart e-mail and transmission of the e-mail, comprising:

a generating unit constructed to generate an e-mail by describing a first character codes acquired by a first acquiring unit in a data area in a first part of the e-mail and the first classification information identified by the identification unit in a header area in the first part of the e-mail, and by describing the second character codes acquired by the second acquiring unit in a data area in a second part of the e-mail and a second classification information which indicates a type of the second character codes in a header area in the second part of the e-mail (figure 2 show a multipart email; see [0086], header fields 252 and body 256; [0087], a second part 270 which includes a second header 272 and second body 276 as shown in figure 2. [0086], "header fields conventionally define the type of data contained in body and may specify any encoding necessary for the purposes of transfer of information contained in the body through the mail system so that the receiving program can reverse the process"; [0089]); and

a transmission unit constructed to transmit the e-mail generated by the generating unit ([0089] indicates such multipart message was transmitted from another server via SMTP).

However, Hockey does not expressly disclose a scanning unit constructed to scan an image on a document; a first acquiring unit constructed to execute a character recognition processing for the image scanned by the scanning unit and acquire, as a result of the character recognition processing, first character codes which are character codes of characters included in the image; an identification unit constructed to identify first classification information which indicates a type of the first character codes; a second acquiring unit constructed to acquire second character codes which are character codes of characters input by a user via a character input unit. Ayako discloses a scanning unit constructed to scan an image on a document [0009], ""the image in the document is read by a scanner via the scanner interface"; a first acquiring unit

constructed to execute a character recognition processing for the image scanned by the scanning unit and acquire, as a result of the character recognition processing, first character codes which are character codes of characters included in the image; an identification unit constructed to identify first classification information which indicates a type of the first character codes ([0009], "the input image data become stored...the character recognizing/language identifying means 5 is then started up. Then the identifier characters contained in the above image data become recognized by using the identifier character dictionary 3...the characters contained in the input image data become recognized by the language L1 character recognizing means 6 by using the language L1 dictionary..."); a second acquiring unit constructed to acquire second character codes which are character codes of characters input by a user via a character input unit ([0015], "text data is input by the document inputting means 14...carried out via the communication interface part or keyboard interface part 29". The keyboard interface indicates user input).

At the time of invention, it would have been obvious to a person of ordinary skilled in the art to combine the teachings disclosed by Hockey, with the teachings disclosed by Ayako. The suggestion/motivation of the combination would have been to be able to read image data (Ayako, page 16, lines 1-3) as well as user input data into email.

As to claim 21, see similar rejection to claim 18.

As to claim 19, Hockey-Ayako discloses communication apparatus according to claim 18, wherein the identification unit identifies the first classification information by determining a kind of language corresponding to the characters included in the image and the first acquiring unit executes the character recognition processing in accordance with the identified first classification information (Ayako, [0009], "the identifier characters contained in the image data

become recognized...the characters contain in the input image data become recognized by the language character recognizing means by using the language L1 dictionary 1 if the language used for the image data is the language L1”).

2. Claims 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hockey in view of Ayako, as applied to claim 18 above, and further in view of Schirris (US 2002/0193986).

As to claim 20, Hockey-Ayako discloses the identification unit identifies the first classification information in accordance with the kind of language and the first acquiring unit executes the character (Ayako, [0009]) but does not expressly disclose an accepting unit constructed to accept a designation of a kind of language from a user. Schirris discloses an accepting unit constructed to accept a designation of a kind of language from a user (figure 6, “receive language”; figure 9, icons to pick a language).

At the time of invention, it would have been obvious to a person of ordinary skilled in the art to combine the teachings disclosed by Hockey-Ayako with the teachings of Schirris regarding accepting a user's language input, so that the Ayako's system uses the user's language input to identify characters, instead of calculating the frequency of language occurrences. The suggestion/motivation of the combination would have been to increase user friendliness.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUA FAN whose telephone number is (571)270-5311. The examiner can normally be reached on M-F 9am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rupal D. Dharia/  
Supervisory Patent Examiner, Art Unit  
2400



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/H. F./

Examiner, Art Unit 2456